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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,019

11/14/2003

Chantal Jubinville

SGI-5

1966

22827 7590 09/11/2008

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EXAMINER

RENDON, CHRISTIAN E

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

09/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/714,019	<b>Applicant(s)</b> JUBINVILLE ET AL.	
	<b>Examiner</b> CHRISTIAN E. RENDÓN	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-16,18-25,27-34,36-43 and 45-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-16,18-25,27-34,36-43 and 45-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to the amendment filed on 6/30/08 in which applicant has responded to claim rejections. Claims 1-2, 4-9, 11-16, 18-25, 27-34, 36-43 and 45-52 are still pending.

### ***Claim Rejections - 35 USC § 103***

**Claims 1-2, 4-9, 11-16, 18-25, 27-34, 36-43 and 45-52 rejected under 35 U.S.C. 103(a) as being unpatentable over Powerball in view of DeFrees-Parrott et al. (US 6,913,534 B2).**

1. Regarding claims 1, 5-6, 8, 12-13, 15, 19-20, 22-24, 28-29, 33, 37-38, 42, 46-47 and 51-52, the lottery game called Powerball requires a player to select five out of 53 numbers and one red ball number from 42 possible choices as the next possible winning number combination. In other words, a player picks a number of game indicia (5) out of set ranging from one to a maximum number (53) and selects a supplemental entry from a second unique set containing a maximum number of indicia that is less than the first set. Besides using large prize amounts as a means to attract players, Powerball also promotes itself as having "9 Ways to Win" transmitting an aura of great odds towards the player. A player is able to win by matching all five selected numbers plus the red number, just the five numbers, four numbers plus the red ball number or even by just matching the red ball number. Since the selection of five number and red number are considered separate games, a player is able to maximize their prize amount by matching everything; \$100,000 for matching the five numbers, a separate prize amount for matching the red ball number and a third bonus prize amount. Therefore Powerball teaches a first, second and third occurrence of a wagering game that offer prizes based on each outcome occurrences.

2. DeFrees-Parrott discloses a slot machine or terminal connected to a host computer through a network. When a player activates the lottery game (DeFrees-Parrott: col. 8, line 63), the player is given the chance to use the interface to input their lottery numbers (DeFrees-Parrott: col. 9, line 1).

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The host computer decides or randomly picks the 'winning numbers' (DeFrees-Parrott: col. 5, lines 65-66), which are compared with the player's numbers by the terminals (DeFrees-Parrott: col. 12, lines 1-3). The lottery game can be any popular lottery game offered by many states like Powerball (DeFrees-Parrott: col. 3, lines 58-62). Therefore it would have been obvious to one of ordinary skill in the art to choose Powerball as the lottery game offered by DeFrees-Parrott's terminal as a means to win a large prize (DeFrees-Parrott: col. 2, lines 1-2).

3. Regarding claims 2, 9, 16, 25, 34 and 43, DeFrees-Parrott discloses a "Quick Pick" option that allows the system to automatically choose the player's numbers (DeFrees-Parrott: col. 2, lines 60-63).

4. Regarding claims 3, 10, 17, 26 and 35, DeFrees-Parrott discloses that the terminals are able to accept a player's lottery number through the interface (DeFrees-Parrott: col. 9, line 1).

5. Regarding claim 4, 11, 18, 27, 36 and 45, in a game of Powerball a player and the computer chooses from a range of 1 to 55 numbers a maximum of 5 numbers. Even though the applicant claims a larger range of numbers, the Examiner views this limitation as mere design choice. Since a different range of numbers only changes the odds of winning, still producing a predictable outcome.

6. Regarding claims 7, 14, 21, 32, 41 and 50, DeFrees-Parrott discloses that a player has to fulfill certain predetermined conditions in order to play a progressive jackpot lottery game (DeFrees-Parrott: col. 13, line 5).

7. Regarding claims 30-31, 39-40 and 48-49, the system disclosed by DeFrees-Parrott is able to operate a variety of lottery game like Powerball (DeFrees-Parrott: col. 3, lines 58-62). Therefore the terminal is able to determine a first prize, if any, the player will receive. This decision is based on how many game indicia were matched.

### ***Response to Arguments***

8. Applicant's arguments filed 6/30/08 have been fully considered but they are not persuasive. As stated above the Examiner views the selection of five numbers from a range of 1 to 53 numbers as a

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selection of a subset “between 1 and less than a predetermined maximum number”. In other words, the applicant fails to claim allowing a player to choose the type of lottery game and odds based on the selection size. It is well known in the art to make this decision by deciding to pick up a “Pick 10” over a “Take 5”. In addition, Powerball is considered to contain more than one occurrence game since each game has its own prize based on different ranges. Thus the prior art teaches the limitation of the game indicia in the first and second subset is unique. The Examiner further argues the claim language fails to describe the applicant’s intentions of claiming a second subset consisting of the numbers not chosen for the first subset since the second subset is defined based on a size less than the first subset. Additionally, the size of the subset is considered design choice since no stated problem is solved by the defined size. Also the limitations fail to claim accepting a wager for a second occurrence game not that it would make much of a difference since it is well known in the art to allow multiple wagers in a single game and hierarchical bets.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTIAN E. RENDÓN whose telephone number is (571)272-3117. The examiner can normally be reached on 9 - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRISTIAN E RENDÓN/  
Examiner  
Art Unit 3714

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/XUAN M. THAI/  
Supervisory Patent Examiner, Art Unit 3714